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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/409,457 09/30/99 FLAUTT M 24649A

IM22/1009
OWENS CORNING SCIENCE & TECHNOLOGY
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EXAMINER

EGWIM,K

ART UNIT	PAPER NUMBER
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1713

DATE MAILED:

10/09/01

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/409,457

Applicant(s)

FLAUTT ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an article with a cured water-resistant coating comprising a water-soluble superabsorbent polymer, does not reasonably provide enablement for an article with a water-resistant coating comprising a water-soluble superabsorbent polymer precursor (uncured). The present disclosure teaches that the cured coating is **formed from** curing the water-soluble polymer "precursor", and as such, the water-soluble polymer in the present coating is no longer the "precursor" but the cured polymer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to prepare such an article commensurate in scope with these claims.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kono et al. or Shiono et al. for reasons cited in the previous Office action.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Manning et al. for reasons cited in the previous Office action.

6. Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kroesbergen for reasons cited in the previous Office action.

Claim Rejections - 35 USC § 103

7. Claims 9-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kono et al., Shiono et al., Kroesbergen or Manning et al. for reasons cited in the previous Office action.

8. Claims 1-5 and 8-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Gaa et al. or Cossement et al. for reasons cited in the previous Office action.

9. Claim 1-15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arroyo et al. or Geursen et al. in combination with Barch et al. for reasons cited in the previous Office action.

Response to Arguments

10. Applicant's arguments filed 7/30/01 have been fully considered but they are not persuasive.

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11. Regarding applicant's arguments against Kono et al., Shiono et al., Manning et al., Kroesbergen, Gaa et al., Cossement, or Arroyo et al. or Geursen et al. in combination with Barch et al., as stated above, the claims to the article with a water-resistant coating comprising a water-soluble superabsorbent polymer **precursor** are not enabled.

Also, while the references do not expressly disclose the coatings to be prepared from an aqueous solution as recited in the present claims 8-15, the product is still the same as the presently claimed product. In any event, an otherwise old product or composition is not patentable regardless of any new or unexpected utility or properties. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

12. Regarding applicants argument against the rejection of claims 9-15 over Kono et al., Shiono et al., Manning et al., Kroesbergen, it is noted that the features upon which applicant relies (i.e., a binder selected from a group consisting of polyester, urethane, epoxy, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also, as recited in the previous Office action, while the cited art may not expressly teach the disclosed properties of the claimed coating, it is still reasonable that the prior art coatings would poses the presently claimed properties since the compositions are essentially the same as the claimed composition and the USPTO

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does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition or article is not patentable regardless of any new or unexpected properties. *In re Fitzgerald et al*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

13. Further, regarding applicant's arguments against Gaa et al. or Cossement et al., applicant has failed to point out where either of these references allegedly discloses that the water resistant coatings shed water on contact.

14. In response to applicant's arguments against the 103 references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each of Arroyo et al. (col. 3, line 1-15 and col. 4, lines 11-20) and Geursen et al. (col. 1, lines 7-10 and col. 3, lines 31-41) teach superabsorbent-coatings for fibrous substrate comprising a water-soluble polymer and other optional component such a viscosity modifying polymers and Barch et al. (See col. 6, lines 18-20) teach the incorporation of binders into coating compositions for fibrous substrate for the purpose of facilitating the formation of a film on the substrate upon the drying of the coating composition.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3599 for regular communications and 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

KCE
October 9, 2001


DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700